

REMARKS

Claims 1, 3, 11 and 13 have been amended, and claims 7-10 cancelled. The claims remaining for consideration are claims 1-4, 6, and 11-15.

Claims 1-4, 6, and 11-15 stand rejected under 35 U.S.C. §102(b) as being anticipated by Hirai *et al.* The Examiner states that the reference discloses a variety of bases and a variety of tertiary alcohols used in the process of for the production of 3-isochromanone, and thus anticipates the instant claims.

In the amended claims, claim 1 has been amended by (a) redefining the hindered amine base as N,N-diisopropylethylamine (Hünig's base), (b) redefining the catalyst as a palladium catalyst and (c) introducing the feature of cancelled claim 7, which defines the molar ratio of the amine base and o-xylene- α,α' -dihalide starting material. The basis for the redefinition of the hindered amine base as N,N-diisopropylethylamine is to be found on page 4, lines 22-23 of the specification and in the examples. The fact that it is the only amine used in all nine examples clearly indicates that it is the preferred amine. The basis for the redefinition of the catalyst as a palladium catalyst is to be found in the passage running from page 2, line 29 to page 3, line 26, in the examples and in claim 10. Various palladium catalysts are exemplified showing support for the scope of this term. The definition of the tertiary alcohol in claim 1 remains unchanged. Both tertiary butanol and tertiary amyl alcohol are exemplified in the specification and further examples are given in the experimental evidence in the attached Declaration under 37 C.F.R. §132. These further examples illustrate the use of a higher molecular weight monohydric tertiary alcohol, 3,7-dimethyl-3-octanol, and a dihydric tertiary alcohol, 2,3-dimethyl-2,3-butanediol (pinacol), showing that the term "tertiary alcohol" is well supported.

The present invention, as defined in the new set of claims, differs from the process disclosed in US 5,886,211 (Hirai *et al.*) in as much as the base used in the present invention is N,N-diisopropylethylamine (Hünig's base). While Hirai *et al.* mention that tertiary amine bases may be used as hydrogen halide capturing agents (page 7, lines 6-12) only pyridine, triethylamine, trimethylamine and tri-n-butylamine are listed. There is no mention of the use of Hünig's base.

Surprisingly, Hünig's base is superior to other tertiary amine bases in terms of the total yield of 3-isochromanone obtained. The experimental evidence presented in the attached Declaration under 37 C.F.R. §132 demonstrates this. There is no teaching by Hirai *et al.* that would lead a skilled person to Applicants' invention. Hirai *et al.* show a clear preference for the use of inorganic bases. No tertiary amine bases are exemplified by Hirai *et al.* and Hünig's base does not feature amongst those mentioned.

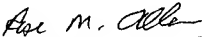
The attached Declaration under 37 C.F.R. §132 of Dr Alan Whitton, who is one of the inventors, shows that N,N-diisopropylethylamine (Hünig's base) is a superior amine base in terms of the yield of 3-isochromanone obtained. The results also show that other tertiary alcohols are suitable for carrying out the invention process.

In view of the comments above and the attached Declaration under 37 C.F.R. §132, Applicants submit that the instant invention is not anticipated by Hirai *et al.* since there is no disclosure of the use of Hünig's base (N,N-diisopropylethylamine) as recited in the amended claims. Withdrawal of the rejection under 35 U.S.C. §102(a) is respectfully requested.

No other rejections standing, early and favourable issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

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